

In re Patent Application of:

**CHAPMAN ET AL.**

Serial No. **09/596,629**

Filing Date: **June 19, 2000**

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**REMARKS**

Applicants would like to thank the Examiner for the thorough examination of the present application. The arguments supporting patentability of the claims are presented in detail below.

**I. The Claims Are Patentable**

The Examiner rejected independent Claims 1, 12, 22, 31, 42, 52 and 61 over the Hager et al. patent (U.S. Patent No. 5,377,355). The present invention, as recited in independent Claim 1, for example, is directed to a method for distributing an invention disclosure over an intranet. The method comprises creating and submitting an invention disclosure over the intranet, with the invention disclosure being submitted by an inventor to at least one evaluator via e-mail with a hyperlink to the invention disclosure. The method further comprises transmitting evaluation comments of the invention disclosure by the at least one evaluator via e-mail.

The method in accordance with the present invention advantageously allows users to exchange e-mail messages within the intranet for providing notification and status of the invention disclosure. Moreover, the hyperlinks embedded within selected e-mail messages advantageously allows a user to access the invention disclosure to provide a user friendly and efficient method of distributing an invention disclosure within an organization or company.

Referring now to the Hager et al. patent, an automation of procedures in a local area network (LAN) environment is disclosed. The procedures are automated in a

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data processing system with regard to the invention disclosures stored therein. As correctly noted by the Examiner, Hager et al. fails to disclose the invention disclosure being submitted via e-mail with a hyperlink back to the invention disclosure.

The Examiner has taken Official Notice that hyperlinks to a document were well known in the art at the time of the invention. Consequently, the Examiner has taken the position that it would have been obvious at the time of the invention to modify Hager et al. to include sending an invention disclosure via an e-mail with a hyperlink back to the invention disclosure.

The Applicants respectfully submit that it would not have been obvious to include a hyperlink to the invention disclosure in Hager et al. when submitted to an evaluator via e-mail, as in the claimed invention. In fact, Hager et al. teaches away from hyperlinks because the disclosed system is not web based, and consequently, each evaluator receives the actual invention disclosure instead of a hyperlink to the invention disclosure. Reference is directed to column 7, lines 5-17 of Hager et al. which provides:

"After receiving a request for an invention disclosure document evaluation, block **96** illustrates the obtaining of a copy of the invention disclosure document and the displaying of the disclosure document to the evaluator and/or printing of a hard copy thereof."

To view the invention disclosure, the evaluator either prints out a hard copy or views it on their computer. It appears that the Examiner is impermissibly using the

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teachings of the present invention as a road map to modify Hager et al. in an attempt to produce the claimed invention. In other words, there must be some reason given in the prior art why one of ordinary skill would have been prompted to combine the teachings of Hager et al. and the Official Notice taken by the Examiner in an attempt to arrive at the claimed invention. The prior art references, individually, or in combination, do not teach or suggest such a combination.

In addition, independent Claim 10, for example, recites the step of "including an attachment to the invention disclosure document." The Examiner has taken the position that column 4, lines 40-61 of Hager et al. discloses this feature of the present invention. However, upon review of Hager et al., there is no mention of attachments being included with the invention disclosure.


Accordingly, it is submitted that independent Claim 1 is patentable over Hager et al. Independent Claims 12, 22, 31, 42, 52 and 61 are similar to independent Claim 1. Therefore, it is submitted that these claims are also patentable over Hager et al. In view of the patentability of the independent Claims 1, 12, 22, 31, 42, 52 and 61, it is submitted that their dependent claims, which recite yet further distinguishing features of the invention, are also patentable. These dependent claims require no further discussion herein.

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**CONCLUSION**

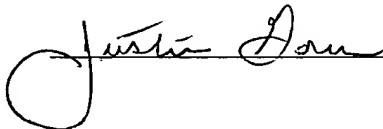
In view of the arguments provided herein, it is submitted that all the claims are patentable. Accordingly, a Notice of Allowance is requested in due course. Should any minor informalities need to be addressed, the Examiner is encouraged to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,

  
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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: MAIL STOP NON-FEE AMENDMENT, COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450, on this 30<sup>th</sup> day of December, 2003.

  
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